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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/848,841	04/30/97	BISTRACK	C BISTRACK-3.0
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EXAMINER

WALCZAK, D

ART UNIT

PAPER NUMBER

3751

DATE MAILED:

4
07/30/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/848,841

Applicant(s)
Bistrack

Examiner
David J. Walczak

Group Art Unit
3751



☒ Responsive to communication(s) filed on Jul 13, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) 1-26 and 28-34 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 27 and 35-38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election of Species

1. Applicant's election without traverse of Species VIII in Paper No. 3 is acknowledged.

The Applicant contends that claims 26-38 are readable on this species, however, claim 26 recites a shelf surface which is aligned transverse to a longitudinal axis of the device, which is not shown in the elected embodiment and claims 28-34 recites a D-shaped perimeter, which is also not present in the elected embodiment. Accordingly, claims 27 and 35-38 are readable on the elected species and will be examined herein.

Specification

2. The disclosure is objected to because of the following informalities: On page 41, line 17, "Figure 29B" should be --Figure 29C--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 27 and 35-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to claim 27, the phrase "a barrel portion held by a barrel portion" (lines 3-4) is unclear. Further, the description of the body of the gripping device is unclear, i.e., it is difficult to determine how the language in this description reads on the structure

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shown in Figures 28 -30 when reading this description while looking at the embodiment shown in Figures 28 - 30. Further, it appears that some of the surfaces gripping device are described more than one time in this claim. Also in regard to claim 27, on line 24, "a lower portion thereof" is indefinite in that it is unclear as to which lower portion is being referred to and on line 27, an antecedent basis for "the opening in the first end" should be defined. In regard to claim 35, it is unclear as to how the "two remaining sides" can have both generally linear surfaces and have a generally hour-glass shape (see lines 14-20).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 27, 35 and 36, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Jahn. In regard to claims 27 and 35, the Jahn reference discloses a pen comprised of a barrel portion 1, an operating portion A and a gripping portion between the operating portion and the barrel portion which is shaped as claimed. In regard to claim 36, the operating portion is a writing point which includes a tubular supply member e and which is aligned such that its longitudinal axis is displaced from the central axis of the barrel portion.

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Allowable Subject Matter

6. Claims 37 and 38 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Sawyer, Plach and Riedel references are cited for disclosing other gripping elements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Walczak whose telephone number is (703) 308-0608.

D Walczak

July 27, 1998


DAVID J. WALCZAK
PRIMARY EXAMINER